

REMARKS

Although the original application in this case was filed with three claims, the Office Action mailed August 3, 2006, only discussed claims 1 and 2. Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sparling ('451) in view of Smith (US 6,355,169). Claim 2 was rejected under 35 U.S.C. § 102(b) as being anticipated by Sparling (US 5,766,451).

Although it is believed that claims 1-3 of the original application are not anticipated or made obvious by Sparling or a combination of Sparling in view of Smith, claims 1-3 have been cancelled with claims 4-8 having been added to the application. It is believed that claims 4-8 are allowable over the prior art of record as will be discussed hereinbelow.

With respect to the Examiner's rejection under 35 U.S.C. § 102(b) on the basis of Sparling, Sparling relates to an inline pressure oil filter adapter which places an anti siphon or anti-drain back valve into the stream of lubricant pumped to lubricate the engine or mechanical device to keep the lubricant from draining out of the lubrication system and oil filter once the lubrication pump providing the stream of lubricant is turned off. The fluid filter adapter of Sparling does not enable a replacement oil filter canister to be substituted for the standard oil filter canister as required by claims 4-8. Claim 4 specifically describes that the replacement oil filter canister has a length greater than the standard oil filter canister and has an O-ring or gasket provided thereon which has a greater diameter than the standard canister O-ring or gasket. It is the annular seat 46 provided at the filter side of the adapter which enables the larger

1 diameter O-ring or gasket of the replacement oil filter to sealably engage the same.
As seen in Fig. 3 of Sparling, the O-ring or gasket 36 on the engine side of the adapter
has the same diameter as element 26. Thus, Sparling cannot anticipate claims 4-8.

5 Claim 5 is dependent from claim 4 and further describes that the threads of the
internally threaded central opening of the disc-shaped adapter member are different
than the threads of the hollow nipple. Claim 6 depends from claim 4 and describes
that the threads of the internally threaded central opening of the disc-shaped adapter
member are SAE threads and the threads of the hollow nipple are metric threads.
10 Claim 7 depends from claim 4 and describes that the annular seat on the filter side of
the disc-shaped adapter member has a width sufficiently large enough to enable
replacement oil filter canister O-rings or gaskets of various diameters to be placed into
sealing engagement therewith. Claim 8 depends from claim 4 and describes that the
disc-shaped adapter member and the hollow nipple are of one-piece construction.

15 Claims 5-8 are believed to be allowable for the reasons expressed in support of
claim 4 above and further in that Sparling does not teach any of the limitations of
claims 5-8 nor does Sparling make claims 5-8 obvious under 35 U.S.C. § 103(b).

20 With respect to the Examiner's reliance upon Smith, Smith does not teach an
adapter which has a hollow nipple extending therefrom to enable a replacement oil
filter canister to be secured thereto. Further, there is no teaching or suggestion in
Smith that the adapter could have an annular shoulder or seat provided thereon which
is adapted to engage the O-ring or gasket of a replacement oil filter canister wherein

1 the O-ring or gasket of the replacement oil filter canister is greater than the O-ring or
gasket of a standard oil filter canister.

5 Even if the Sparling and Smith references taught the structure as suggested by
the Examiner, for purposes of argument only, there is absolutely no motivation or
suggestion therein to combine the same. Further, the resultant structure would not
have the structure of claim 4 nor the structure of dependent claims 5-8.

10 Applicant has provided an adapter which enables replacement oil filter canisters
to be substituted for standard oil filter canisters wherein the threads of the replacement
oil filter canisters may be different than the threads of the oil tube of the engine
receptacle and wherein the diameter of the O-ring or gasket on the replacement filter
is greater than the diameter of the O-ring or gasket on the standard oil filter canister.
Applicant's invention enables replacement oil filter canisters having a greater capacity
than the standard oil filter canisters as discussed at length in the specification.
15 Applicant has provided a truly unique oil filter adapter which is not anticipated by the
prior art nor made obvious. Accordingly, the claims in this application should be
allowed.

20 No fees or extensions of time are believed to be due in connection with this
Amendment; however, please consider this a request for any extension inadvertently
omitted and charge any additional fees to Deposit Account No. 502093.

Respectfully submitted,



DENNIS L. THOMTE
Registration No. 22,497
THOMTE, MAZOUR & NIEBERGALL
Attorneys of Record

2120 S. 72nd Street, Suite 1111
Omaha, NE 68124
(402) 392-2280

CERTIFICATE OF MAILING

I hereby certify that the original of this AMENDMENT for MYRON L. MUNN, Serial No. 10/829,005, was mailed by first class mail, postage prepaid, to Mail Stop Amendment, Commissioner for Patents, Alexandria, VA 22313, on this 30th day of October, 2006.



DENNIS L. THOMTE